

AF/3627
EPCW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William C. Bullard

Serial No. 09/276,277

Filed: 03/25/1999

For: **FLOW PROBE CONNECTIVITY DETERMINATION**

Examiner: Rudy, Andrew

Art Unit: 3627

Mail Stop Appeal Brief - Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

RESPONSE TO NOTICE OF NON COMPLIANCE

Appellant is in receipt of a Notice of Non-Compliance With 37 C.F.R. § 1.192(c). The alleged bases for non-compliance is that the brief does not contain a concise statement of the issues presented for appeal, and that the Summary of the Invention was deficient.

Appellant respectfully disagrees with the assertion that the Appeal Brief was non-compliant with respect to the concise statement of the issues presented for appeal. The Appeal Brief as originally filed stated on page 3:

“(6) ISSUES

Whether claims 2-15, 19-22, 24, and 26-28 are obvious under 35 U.S.C. § 103 as being unpatentable over Jorgensen.” Appellant’s statement conforms to the example presented in MPEP § 1206, and accurately reflects the single issue presented in the current appeal. Appellant requests withdrawal of the Patent Office’s assertion that the Appeal Brief is non-compliant in this regard.

Appellant further disagrees that the Summary of the Invention is non-compliant. The Patent Office states that the Appellant’s summary “does not properly provide a brief summary for the multiple independent [sic] claimed inventions.” Appellant disagrees with this statement. All the claims of the present appeal stand or fall together, and the multiple independent claims have scopes that are substantially the same allowing for the differences between method, apparatus, and computer software claims. Thus, Appellant’s Summary provides the required brief summary for the multiple independently claimed inventions.

The Patent Office goes on to state that the features claimed should coincide with the language of the Appeal Brief. Appellant disagrees. 37 C.F.R. § 1.192(c)(5) states that the brief

shall contain a "concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters." MPEP § 1206 expands on this by stating:

A concise explanation of the invention defined in the claims involved in the appeal. This explanation is required to refer to the specification by page and line number, and, if there is a drawing, to the drawing by reference characters. Where applicable, it is preferable to read the appealed claims on the specification and any drawing. While reference to page and line number of the specification may require somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application.

There is no requirement articulated in either location that the features claimed should coincide with the language in the Appeal Brief. Furthermore, an examination of the language used in Appellant's Summary corresponds closely to the language of the independent claims, and the Examiner's implied assertion that the Summary does not correspond to the claim language is incorrect.

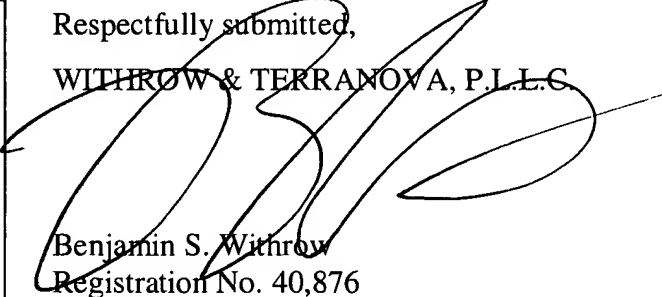
The Patent Office goes on to assert that "various features of the dependent claims are no [sic] addressed, e.g. claim 4, in the Summary." Again, there is no requirement in either 37 C.F.R. § 1.192(c)(5) or MPEP § 1206 that each of the dependent claims be addressed in the Summary, especially where, as here, all the claims stand or fall together.

Nevertheless, to expedite the appeal process, Appellant files herein a Revised Appeal Brief with an expanded Summary of the Invention.

<p align="center"><u>CERTIFICATE OF MAILING</u></p> <p>I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST-CLASS MAIL, IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS, PO BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450, ON OCTOBER 8, 2004.</p> <p><u>REBECCA ROOKS</u> Name of Depositor</p> <p><u>Rebecca Rooks</u> Signature</p> <p><u>10/8/04</u> Date of Signature</p>

Respectfully submitted,

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